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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/050,593  | 01/16/2002  | Charles A. King      | N1375-002           | 4652             |
| 32905   | 7590        | 03/22/2004           | EXAMINER            |                  |
| JONDLE & ASSOCIATES P.C.<br>9085 EAST MINERAL CIRCLE<br>SUITE 200<br>CENTENNIAL, CO 80112 |             |                      | LAMBERTSON, DAVID A |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1636                |                  |

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/050,593

Applicant(s)

KING ET AL.

Examiner

David A. Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24,27-35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) 9,10,16-18 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,11-15,19-24,27-30,32-35 and 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 13, 2003 has been entered.

Claims 1-24, 27-35 and 37-40 are pending in the instant application. Claims 25, 26 and 36 have been cancelled. Claims 9, 10, 16-18 and 31 have been withdrawn from consideration. Claims 1-8, 11-15, 19-24, 27-30, 32-35 and 37-40 are under examination in the instant application.

### ***Claim Objections***

Claims 15 and 30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claims 15 and 30 depend from claims 1 and 27, respectively, and each of these claims recites that the herbicide is "glyphosate herbicide" in the preamble of the claim. Claims 15 and 30 then indicate that the herbicide consists of 5-enopyranylshikimate-3phosphate synthase (EPSPS) inhibitors, which is broader in scope than glyphosate herbicide, which is a single species within the genus of EPSPS inhibitors. As a result

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of this broadening of the scope, the claims fail to further limit the claims from which they depend. **This objection is necessitated by amendment.**

It is noted that claim 38 appears to be missing an article "a" between the terms "comprises" and "superior." It is also noted that the term "inoculation" in the first line of claim 35 may properly be changed to "inoculating" in order to bring it into the same tense as the claim from which it depends.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 11-15, 19-24, 27-30, 32-35, 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **These are new rejections that are necessitated by amendment.**

Claims 1 and 27 recite the limitation "said herbicide" in section "(b)" of the claims. There is insufficient antecedent basis for this limitation in the claim. Specifically, it is unclear if "said herbicide" refers to the glyphosate herbicide, or some other herbicide that is not clearly indicated in the claim. Under most circumstances, it would be clear that "said herbicide" was referring to the glyphosate herbicide; however, in depending claims (e.g., claims 15 and 30), the scope of the herbicide that is used is broadened, raising a question as to the antecedent basis of the term "said herbicide." It is noted that the antecedent basis problem extends to all of the

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dependent claims, and the term "said herbicide" is specifically present in claims 15, 19, 20, 23, 24, 30, 34 and 37.

The term "desired" in claims 1-8 and 21-24 is a relative term which renders the claim indefinite. It is unclear to whom the strain should be desirable when selecting the strain to be used in the claim. It would be remedial to omit the term "desired" from the claims.

Claim 27 is rejected under 35 USC 112, second paragraph, as being indefinite for failing to recite a positive process step that refers back to the preamble of the claim. In order for the claimed method to be definite in terms of the metes and bounds of the invention, the claim must recite a method step that provides for the result of the methods as claimed. It would be remedial to insert the phrase "thereby enhancing dinitrogen fixation of a nodulating leguminous plant" immediately after step (c) in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Loh (as cited in the previous Office Actions; see entire document). **This rejection is maintained for the reasons set forth in the previous Office Action.**

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Applicant indicates that the amendments the claims are believed to be sufficient to overcome the rejections set forth under 35 USC 102(e). However, with regard to these claims, the Loh reference still anticipates the claimed invention because it teaches a Rhizobial strain that expresses any one of a number of herbicide genes (see for example page 4, [0045], [0048]; page 7, [0071]; page 5, [0056]; and page 6-7 [0069]) as a selectable marker. Furthermore, Loh teaches the application of these strains onto plants, thereby teaching a plant that is infected by a Rhizobial strain that is resistant to an herbicide.

*Allowable Subject Matter*

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.  
AU 1636



JAMES KETTER  
PRIMARY EXAMINER